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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
MOEZIE, F

ART. UNIT.	PAPER NUMBER
1554	12

10/13/98

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/050,366

Applicant(s)

Johannsson et al.

Examiner

F. Moezie

Group Art Unit

1654

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 7/19/99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 19-40 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 19-40 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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F.M.

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The response filed 19 July 1999, paper no. 11, has been made of record.

It is duly noted that applicant has canceled previously presented claims 1-18 and presented new claims 19-40. Accordingly, the previous restriction requirement is withdrawn (and thereby the Office action) and replaced with the restriction requirement presented herein below.

***REMARKS: In this regard it is noted that independent claims 19 and 22 are drawn to the use of GH only and not to the GH functional analogs. Consequently, making claims 20 and 23 (referring to GH functional analogs) improperly dependent claims. However, it appears that this omission merely represents an oversight and accordingly the restriction requirement below is being applied as if GH functional analogs had been intended to be incorporated in the independent claims 19 and 22.***

***In view of the above remarks the newly (amended) claims necessitated the following new Restriction Requirement.***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 19-21, 25, 26, 31-38, drawn to a method of using GH for treating abdominal/visceral obesity, classified in class 424, subclass 909 for example.
- II. Claims 19-21, 22-24, 27-30, drawn to a method of using GH for treating insulin resistance, classified in class 514, subclass 866, for example.
- III. Claims 19-21, drawn to a method of using GH for treating lipoprotein aberrations, classified in class 514, subclass 12, for example.

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- IV. Claims 19-21 and 39-40, drawn to a method of using GH for treating hypertension, classified in class 514, subclass 12, for example.
- V. Claims 19-20, 25-26 and 31-38, drawn to a method of using a GH analog for treating abdominal/visceral obesity, classified in class 514, subclass 909, for example.
- VI. Claims 19-20, 22-23 and 27-30, drawn to a method of using a GH analog for treating insulin resistance, classified in class 514, subclass 866, for example.
- VII. Claims 19 and 20, drawn to a method of using a GH analog for treating lipoprotein aberrations, classified in class 514, subclass 12, for example.
- VIII. Claims 19-20 and 39-40, drawn to a method of using a GH analogs for treating hypertension, classified in class 514, subclass 12, for example.

Inventions I-IV and V-VIII are distinct group of inventions. Inventions I-IV are drawn to the use of a GH in a method for treatment whereas inventions V-VIII are drawn to the use of a GH analog in a method for treatment. The compounds used as active agents differ from one another in structure, physical and chemical properties and are capable of separate manufacture and/or use. For example, calcitonin (classified in class 530, subclass 307) or insulin related peptides (classified in class 530, subclass 303) function as growth promoting agents. Hence the restriction between the two groups of inventions is deemed proper.

Additionally, the disease states within Groups I-IV and V-VIII are distinct one from the other as each is drawn to treating a different disease having different modes of operation, different

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functions or different effects. Moreover, their ideologies, symptoms and modes of treatment require separate and independently burdensome manual and electronic searches. Consequently, the restriction requirement is deemed proper as set forth above.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

### *Election of Specie*

In the event applicant elects any one of Groups V to VIII inventions, applicant is further required under 35 USC section 121 to elect a single disclosed specie of GH analog for prosecution on the merits.

A "specie" is a specific compound, with all substituent variables fully accounted for.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention (together with election of a specie for any of Group V-VIII invention) to be examined even though the requirement be traversed (37 CFR 1.143).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F.T. Moezie whose telephone number is (703) 305-4508 or Mr. Woodward at 308-4028.

*F. T. Moezie*  
T. MOEZIE, Ph.D.  
PRIMARY EXAMINER  
ART UNIT ~~186~~  
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